

Appl. No. 10/051,612
Amdt. Dated February 8, 2006
Reply to Office Action of December 15, 2005

REMARKS

The following remarks are responsive to the Office Action mailed December 15, 2005.

Claims 1-18 and 34-42 are currently pending.

Applicant notes with appreciation that Claims 1-9, 11-18 and 35-42 would be allowable if re-written to include the limitations of the independent claims from which they depend.

Independent Claims 1, 10, and 34 are rejected under the judicially created doctrine of double patenting. For the reasons stated below, Applicant believes that those Claims should be passed through to allowance – as the co-owned applications on which the Examiner relies for double patenting rejection are filed later-in-time than the present application.

Double Patenting Rejections:

The Examiner rejects Claims 1, 10 and 34 provisionally under the judicially created doctrine of double patenting under the following basis:

- 1) Claims 1, 10 and 34 are provisionally rejected over claim 10 of copending Application No. 10/278,352. (hereinafter “the ‘352 application”)
- 2) Claims 1, 10, and 34 are provisionally rejected over claims 21 and 30 of copending Application No. 10/278,352.
- 3) Claims 1, 10, and 34 are provisionally rejected over claim 12 of copending Application No. 10/278,353. (hereinafter “the ‘353 application”)

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4) Claims 1, 10, and 34 are provisionally rejected over claims 25 and 34 of copending Application No. 10/278,353.

The Examiner notes that these rejections are provisional as the conflicting claims in the '352 and '353 applications have not yet been patented.

Without going to the substance of the Examiner's analysis of overlapping subject matter between Claims 1, 10 and 35 of the present application with claims of the '352 and the '353 applications, Applicant respectfully submits that the present provisional rejections to Claims 1, 10, and 35 be removed – as the '352 and the '353 applications are filed later in time to the present application.

Applicant directs the Examiner's attention to MPEP section 1490 for support of Applicant's position.

MPEP 1490 states in relevant part:

"D. Two or More Copending Applications

If two (or more) pending applications are filed, in each of which a rejection of one claimed invention over the other on the ground of provisional obviousness-type double patenting (ODP) is proper, the ODP rejection will be made in each application. If the ODP rejection is the only rejection remaining in the earlier filed of the two pending applications, (but the later-filed application is rejectable on other grounds), the examiner should then withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only

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rejection remaining in the later-filed application, (while the earlier-filed application is rejectable on other grounds), a terminal disclaimer must be required in the later-filed application, before the ODP rejection can be withdrawn.

If the ODP rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application be permitted to issue.

If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.

Where there are three applications containing claims that conflict such that an ODP rejection is made in each application based upon the other two, it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. Rather, an appropriate terminal disclaimer must be filed in at least two of the applications to link all three together. This is because a terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed; it is not effective to link the other two applications to each other." (Bold emphasis added).

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For the convenience of the Examiner, Applicant submits a separate IDS that includes the Office Actions and Responses in the '352 and the '353 application – as well as several other co-owned and co-pending applications.

As may be seen by the Examiner, there are other grounds for rejection in the '352 and the '353 applications. Additionally, as may be seen from the language excerpted from MPEP 1490, it is appropriate that – if the only rejection remaining the earlier filed case is double patenting in view of later-filed cases, that the earlier-filed case should be allowed to issue without the need of a terminal disclaimer.

Applying the rule stated above in MPEP 1490, Applicant respectfully requests that the present rejection to Claims 1, 10, and 34 be removed and the applicant passed through to allowance without requiring a terminal disclaimer.

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Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that all pending Claims are patentable over the cited art of record and are in condition for allowance. Therefore, Applicant requests the Examiner to reconsider and withdraw the outstanding rejection and pass this application to allowance.

If the Examiner believes a telephone conference would expedite the allowance of the claims, the Examiner is invited to contact Stuart P. Kaler at (707) 824-2487.

Respectfully submitted,

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